

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In re**

**Application of: Robert Mechaley Jr. et al.**

**Serial No.: 08/804,900**

**Examiner: Frantzy Poinvil**

**Filed: February 24, 1997**

**Group Art Unit: 3628**

**For: METHOD FOR INCREASING SYSTEM RESOURCES TO A USER**

**Attorney Docket No.: 59359-00601**

**MAIL STOP APPEAL BRIEF**

**Commissioner for Patents**

**P.O. Box 1450**

**Alexandria, VA 22313-1450**

**Dear Sir:**

**In response to the Final Office Action dated July 15, 2005 and pursuant to 37**

**C.F.R. 1.192, Appellants submit the following Appeal Brief.**

01/19/2006 HALI11 00000058 032469 08804900

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## **APPEAL BRIEF**

### **I. REAL PARTIES IN INTEREST**

The inventors of the Application at issue are Robert Mechaley Jr. and Richard A. Miner. All inventors have assigned their rights to Wildfire Communications, Inc. which has subsequently assigned those rights to Orange S.A.

### **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences known to Appellant, Appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending Appeal.

### **III. STATUS OF THE CLAIMS**

Claims 1 – 8 and 25 - 37 are pending in the present Application. Claims 1 – 8 and 25-26 were rejected in a Final Office Action dated July 15, 2005. Claims 27 - 37 were withdrawn by the Examiner from consideration as being directed to a non-elected invention. The final rejection of all claims is appealed.

### **IV. STATUS OF AMENDMENTS**

No Amendments were filed after the Final Rejection.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

Generally, the Applicant's invention is directed to a method and system of controlling provision of software components from a set of predefined software components, each component providing a distinct functionality. In one embodiment, the invention is implemented in the context of a voice responsive telephone assistant, and provision of an as-yet unused component is dependent on monitored usage of components within the set that have previously been provided to the user.

The following passages set forth the content of the independent claims currently on file at the USPTO (as per the communication filed 19 April 2005), and make reference to passages in the application documents filed on 24 February 1997.

Claim 1 recites a computer implemented and user interactive method of controlling provision of software components from a set of software components, as described between lines 5 – 9 of page 9. Claim 1 requires that the composition of the set be predefined (as described between line 25, line 8 – 20 of page 9 and line 32, page 9 – line 1, page 10) and that each software component provides a distinct functionality (see lines 28 – 32 of page 8). The steps recited in claim 1 include providing a computer system with a subset of software components from the set of software components, as described inter alia in the passages between lines 5 – 7 of page 9 and lines 6 – 7 of page 10, and collecting usage data describing user interactions with the subset of software components, as described inter alia in the passages between lines 7 – 10 of page 10, and lines 12 – 23 of page 11. Claim 1 also includes the step of analyzing the usage data so as to identify a usage pattern, as described in the passage between line 25 of page 11 – line 10 of page 12, and the step of identifying a software component

from the set based on the identified usage data pattern and predetermined rules specifying a relationship between usage of a first software component and selection of a second, different, software component, as described in the passage between lines 11 – 24 and lines 11 – 16 of page 13 (in particular point 4 “Sell up Rules” on page 12), both said components being within said predefined set of software components, as is implicit from the passage between line 13 of page 9 and line 11 of page 11. The final step recited in claim 1 is that of alerting the user to an availability of said identified software component, as described in the passage between lines 13 – 20 of page 13, wherein said identified component is not within the subset of software components, it being implicit from the passages between lines 1 – 11 of page 11 and lines 15 – 24 of page 12 that the identified component is not one that was originally provided.

Claim 26 recites a computer implemented and user interactive method of controlling provision of software components from a set of software components, as described between lines 5 – 9 of page 9. Claim 26 requires that the composition of the set be predefined (see lines 15 – 20 of page 9) and that each software component provides a distinct functionality (see lines 28 – 32 of page 8). The steps recited in claim 26 include providing a computer system with a subset of software components from the set of software components, as described inter alia in the passages between lines 5 – 7 of page 9 and lines 6 – 7 of page 10, and collecting usage data describing user interactions with the subset of software components, as described inter alia in the passages between lines 7 – 10 of page 10, and lines 12 – 23 of page 11. Claim 26 also includes the step of analyzing the usage data so as to identify a usage pattern indicative of frequency of usage, as described in the passage between line 25 of page 11 – line 10

of page 12, each of the examples set forth in relation to point 3 “Usage Data” on page 11 being related in some way to frequency of usage. Claim 26 also includes the step of identifying a software component from the set based on the identified usage data pattern and alerting the user to an availability of said identified software component, as described in the passage between lines 13 – 20 of page 13, wherein said identified component is not within the subset of software components, it being implicit from the passages between lines 1 – 11 of page 11 and lines 15 – 24 of page 12 that the identified component is not one that was originally provided.

#### **VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1 – 8 and 25 – 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,999,908 to Abelow in view of Majmudar et al. (EPA 0 365 200 A3).

#### **VII. ARGUMENT**

The Office bears the burden of establishing a *prima facie* case of obviousness to support its rejection of Claims 1-8 and 25-26, however, it has failed in this regard. Three basic criteria must be met to establish a *prima facie* case of obviousness. See MPEP § 706.02(j) and §2143; In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143.01; In re Nielson, 816 F.2d 1567, 1569 (Fed. Cir. 1987), citing In re Linter, 458 F.2d 1013, 1016,

173 USPQ 560, 562 (CCPA 1972). Second, there must be a reasonable expectation of success. See MPEP § 2143.02; In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.03; In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. See In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

The references fail to teach all the elements recited in the claims.

Abelow (US 5,999,908) is concerned with collecting data indicative of the user's preferences to design products on dependence on user feedback, Abelow, Col. 71, lines 5 – 7, (some of which is explicitly requested and entered, some of which is implicitly collected, via “probes”), thereby providing a means of enabling the products to evolve in a customer-focused manner. *Id.* at Col. 71, lines 19 – 22.

Since Abelow is concerned with providing a system in respect of which products can evolve, any upgrades that are offered to the user are different to the software modules that the user was issued with in the first instance (and in relation to which the data collected is performed). Thus Abelow does not disclose “provision of software components from a set of software components, wherein composition of the set is predefined” (all independent claims).

The Office suggests that Abelow teaches providing users with additional products and services; however, the section that the Office cites (Abelow, Col. 13, lines 55-58) only concerns point-of-use transactions where the customer directly requests additional

products. The present invention uses usage data patterns to suggest additional products to the customer. Although Abelow describes the collection of data indicative of the user/customer's preferences, Abelow uses the collected data to design products in dependence on user feedback (Id., at col. 71, lines 5-7), which is how the system enables the products to evolve in a customer-focused manner (Id., at col. 71, lines 19-22).

While Abelow may be useful for product evolution based upon the improved communication of user preferences, it quite clearly fails to disclose or suggest various features recited in Applicant's amended claim 1. For example, Abelow does not disclose collecting and analyzing usage data that describes user interaction with a subset of (a predefined set of) software components to identify a usage data pattern. Nor does Abelow identify a software component based on the identified usage data pattern. Furthermore, Abelow clearly does not use predetermined rules specifying a relationship between usage of a first software component and selection of a second, different, software component, both said components being within a predefined set of software components. Again, Abelow accommodates introduction of new features based upon received customer preferences, which clearly differs from the introduction of a component from a predefined set of components based upon a usage data pattern and predetermined rules that specify the relationship between a previously established component and an introduced component.

The Office further states that customers' desires are inputted by the customers for future development and consideration, and concedes that Abelow does not disclose the alerting step. (Office Action mailed July 15, 2005, page 3).

Whilst Abelow mentions selecting additional services and products on the basis of usage, it does not provide any specific details in this regard: the passage in Col. 20, lines 6 – 9 states that “the product learns which customers need additional units and delivers them immediately” but it does not say that such “additional products” are part of a predefined set, and it does not describe how the product identifies which additional units should be selected and delivered. Accordingly Abelow does not disclose:

- “identifying a software component from the set based on said identified usage data pattern and predetermined rules specifying a relationship between usage of a first software component and selection of a second, different, software component, both said components being within said predefined set of software components” (claim 1);
- “analyzing said usage data so as to identify a usage data pattern [in respect of usage data describing user interaction with the subset of [predefined] software components] indicative of frequency of usage” (claim 26); or
- “alerting the user to an availability of said identified software component, wherein said identified component is not within the subset of software components” (all independent claims).

Nor does Majmudar remedy the deficiencies of Abelow. Majumadar is concerned with a telephone system, more specifically a system that enables the functionality of a telephone handset to be upgraded by means of explicit feature selection on the touch screen display associated with the handset. In operation, the touching of various buttons on the screen results in a message to be sent to the



switching system, requesting the display of available features at the handset. In response, the switching system transmits data messages which are interpreted by the terminal software to display a feature selection menu on the touch screen. The user can then select (by means of adding and/or deleting) the features that he wishes to become available, resulting in the associated software functionality to be provided to the handset.

Since selection of a given software component is performed by means of explicit user selection, Majmundar does not disclose:

- “collecting usage data describing user interaction with the subset of software components” (all independent claims),
- “analysing said usage data so as to identify a usage data pattern” (claim 1),
- “analysing said usage data so as to identify a usage data pattern indicative of frequency of usage” (claim 26), or
- “identifying a software component from the set based on said identified usage data pattern and predetermined rules specifying a relationship between usage of a first software component and selection of a second, different, software component, both said components being within said predefined set of software components” (claim 1)

In addition, Majmundar does not disclose “alerting the user to an availability of said identified software component” (all independent claims), since instead of the alerting being performed in dependence on previously performed monitoring and

analyzing of usage data (subject application), the user has to pull information relating to the available software components (Majmudar).

Accordingly, neither Abelow nor Majmudar disclose all of the features of the independent claims of the subject application, either alone or in combination.

Claims dependent on nonobvious independent claims are nonobvious themselves. See In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988). Dependent Claims 2-8 and 25 depend from, and thus incorporate the features recited in independent Claim 1, as well as additional limitations which render the claims patentable.

The rejections also fail to specify either the location in Abelow or Majmudar et al of a suggestion or motivation to modify the teachings of these references to meet the claims, or evidence of the general availability in the art of knowledge that would motivate one of ordinary skill to make such a modification. The Office merely asserts that the "motivation would have been to instantly allow users to make changes in their current usage of a product/service thereby permitting great flexibility of a product/service for better customer service and loyalty." There is no evidence of record to support this "motivation," which appears to be an improper hindsight observation based on the teaching of Applicants' specification. See In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) ("does not include knowledge gleaned only from applicant's disclosure"). In the absence of identifying supportive language for the combination in the references themselves, the rejections must explain how the motivation for the modification or combination of the references was generally available to one of ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1371, 55

U.S.P.Q.2D (BNA) 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 U.S.P.Q.2D (BNA) 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination... the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2D (BNA) 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). Applicants' respectfully submit that the one line provided by the Office does not satisfy this important requirement of establishing a *prima facie* case of obviousness.

## VIII. CLAIMS APPENDIX

1. A computer implemented and user interactive method of controlling provision of software components from a set of software components, wherein composition of the set is predefined and each software component thereof provides a distinct functionality, the method comprising:

providing a computer system with a subset of software components from said set of software components;

collecting usage data describing user interaction with the subset of software components;

analysing said usage data so as to identify a usage data pattern;

identifying a software component from the set based on said identified usage data pattern and predetermined rules specifying a relationship between usage of a first software component and selection of a second, different, software component, both said components being within said predefined set of software components; and

alerting the user to an availability of said identified software component, wherein said identified component is not within the subset of software components.

2. The method of claim 1, in which said collecting step comprises collecting interval of use data for said subset of software components.

3. The method of claim 1, including collecting statistical data regarding use of said subset of software components.

4. The method of claim 1, including collecting demographic data regarding said user.

5. The method of claim 1, including collecting geographic data regarding said user.

6. The method of claim 1, including determining whether any threshold has been satisfied by said collected data.

7. The method of claim 1, including applying a fuzzy algorithm to said collected data to determine whether a said data pattern can be identified.

8. The method of claim 7, further including interactively communicating by a visual mechanism and tactile response mechanism with said user.

9-24. (Cancelled)

25. The method of claim 1, further comprising the steps of:  
collecting data from a plurality of users,  
collecting user decisions from a plurality of users, and  
determining when to alert the user of availability of said identified software component based upon at least group user data and decisions.

26. A computer implemented and user interactive method of controlling provision of software components from a set of software components, wherein composition of the set is predefined and each software component thereof provides a distinct functionality, the method comprising:

providing a computer system with a subset of software components from said set of software components;

collecting usage data describing user interaction with the subset of software components;

analysing said usage data so as to identify a usage data pattern indicative of frequency of usage;

identifying a software component from the predefined set based on said identified usage data pattern; and

alerting the user to an availability of said identified software component, wherein said identified component is not within the subset of software components.

27-37. Withdrawn

**IX. Evidence Appendix**

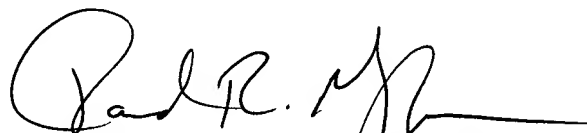
There is no additional evidence presented.

**X. Related Proceeding Appendix**

There are not related proceedings.

In light of the above arguments, Appellants respectfully submit to the Board that the present rejections are untenable, and the Application is in a state for allowance. An oral hearing is respectfully requested.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "David R. Yohannan", with a long horizontal line extending to the right.

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